



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/009,019

03/02/2005

Allesio Casati

Casati 1-1-1

5854

7590

05/22/2008

Docket Administrator
Lucent Technologies Inc
Room 3J-219
101 Crawfords Corner Rd
Holmdel, NJ 07733-3030

EXAMINER

SANTIAGO CORDERO, MARIVELISSE

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

05/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/009,019	Applicant(s) CASATI ET AL.	
	Examiner MARIVELISSE SANTIAGO-CORDERO	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

In addition, regarding claim 2, the common knowledge or well-known in the art statement is taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate; in this case, applicant failed to traverse the examiner's assertion of official notice. See MPEP 2144.03.

Claim Objections

2. Claims 1-7 are objected to because of the following informalities: the term "mode" (claim 1, lines 4 and 5) should be replaced with --node--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-7 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claims 1-7, the limitation "without receiving a mobile Internet protocol agent solicitation message" was not described in the specification in such a way as to reasonably

Art Unit: 2617

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In the Remarks, Applicant did not specifically point out where in the disclosure the Examiner can find support for the amendments made to the claims. Nevertheless, after review of the originally filed disclosure, the newly added limitation is an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. In re Schechter, 205 F.2d 185, 98 USPQ 144 (CCPA 1953). According to MPEP 2173.05(i), any negative limitation or exclusionary proviso must have basis in the original disclosure. Newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. In this case, applicant is adding information that goes beyond the subject matter originally filed with limitations that are not necessarily present in the original disclosure.

Applicant is welcomed to point out where in the specification the Examiner can find support for this limitation, if Applicant believes otherwise.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes et al. (hereinafter "Barnes"; Patent No.: US 6,711,147) in views of Frid et al. (hereinafter "Frid"; cited in PTO-892, paper no. 20071116) and Leu et al. (hereinafter "Leu"; Non-Patent Literature: "Implementation Considerations for Mobile IP").

Regarding claim 1, Barnes discloses a method of supporting mobile internet protocol (Abstract; note the merging of packet service with mobile IP) when a mobile system moves from a former routing area to a new routing area (col. 2, lines 54-64; col. 4, lines 60-66) and sends to a controlling support node (Fig. 5a, reference 284) a routing area update message (Fig. 5a, reference 302; col. 10, lines 26-30), comprising the step of:

the controlling support node receiving a routing area update completion message (Fig. 5a, references 328; col. 10, lines 60-62).

Barnes fails to specifically disclose the controlling support node responding to receipt of the routing area update completion message by sending a mobile Internet protocol agent advertisement to the mobile system without receiving a mobile Internet protocol agent solicitation message.

However, Barnes discloses merging packet service, such as GPRS, with mobile IP (Abstract; col. 4, lines 28-42). Barnes further discloses the controlling support node capable of handling mobile IP specific messaging (Abstract; col. 4, lines 39-42) and a controlling support node/foreign agent using internet protocols (col. 7, lines 50-56). In addition, Barnes discloses the standard mobile internet protocol with three major subsystems including a discovery mechanism which provides mobile nodes with new attachment points (new IP addresses) as they move within the network (col. 3, lines 4-19 and 56-61; fairly characterized as advertisements). When the mobile node learns its new IP address, it registers (col. 3, lines 4-19 and 56-61). Accordingly, Barnes does suggest the controlling support node responding to receipt of the routing area update completion message by sending a mobile Internet protocol agent advertisement to the mobile system.

Nevertheless, in the same field of endeavor, Frid discloses a method of supporting mobile internet protocol when a mobile system moves from a former routing area to a new routing area and sends to a controlling support node a routing area update message (Fig. 6, reference 630; col. 6, lines 10-13; col. 8, lines 41-45), comprising the step of:

the controlling support node responding to receipt of the routing area update message by sending a mobile Internet protocol agent advertisement message to the mobile system (Fig. 6, reference 780).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to send, by the controlling support node responding to receipt of the routing area update completion message of Barnes a mobile Internet protocol agent advertisement message to the mobile system as suggested by Frid for the advantages of determining whether the mobile node is on its home network or a foreign network, enabling the merging of packet service, such as GPRS, with mobile IP, and enabling the controlling support node to be capable of handling mobile IP specific and known messaging.

Barnes in combination with Frid fails to specifically disclose without receiving a mobile Internet protocol agent solicitation message.

However, in the same field of endeavor, Leu discloses sending a mobile Internet protocol agent advertisement message to the mobile system without receiving a mobile Internet protocol agent solicitation message (Section 1:1; note that a mobile node may optionally send the solicitation message).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to send the mobile Internet protocol agent advertisement message of

Barnes in combination with Frid to the mobile system without receiving a mobile Internet protocol agent solicitation message as suggested by Leu for the advantages of complying with standard operation of Mobile IP and reducing network traffic.

Regarding claim 3, in the obvious combination, Frid discloses in which the advertisement is sent on a traffic channel (Fig. 6, reference 780; col. 9, lines 40-44); note that the traffic channel is inherently present).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to send the advertisement on a traffic channel as suggested by Frid for the advantages of ensuring reception of the message.

Regarding claim 4, in the obvious combination, Barnes discloses in which a mobile Internet protocol movement detection algorithm detects a change of foreign agent of the mobile system (col. 3, lines 4-19 and 41-61; col. 4, lines 53-66; col. 5, lines 11-30).

Regarding claim 5, in the obvious combination, Barnes discloses in which on detection of a change of foreign agent, the mobile system is registered by mobile internet protocol registration (col. 3, lines 4-19 and 41-61; col. 4, lines 53-66; col. 5, lines 11-30).

Regarding claim 6, in the obvious combination, Barnes discloses in which the former and new routing areas are within the same or different support networks (col. 4, lines 60-63; col. 8, lines 16-20), and the advertisement (note the explanation of the obvious combination given above for claim 1) is sent after successful sending and receipt of routing area update request, acceptance and completion messages (Fig. 5a, references 302, 326a, and 328, respectively).

Art Unit: 2617

7. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes in combination with Frid and Leu as applied to claim 1 above, and further view of well known prior art.

Regarding claim 2, Barnes in combination with Frid and Leu discloses the method according to claim 1 (see above), but fails to specifically disclose in which the advertisement includes challenge/response and network access identifier extensions.

However, the Examiner takes Official Notice of the fact that at the time of invention by Applicant, it was notoriously well-known in the art to include in the advertisement messages challenge/response and network access identifier extensions for the advantages of communicating the latest challenge value that can be used by the mobile node to compute a challenge response which would serve for authentication and to prevent other network entities from using the network identity to intercept packets, and for the advantages of determining if the mobile node has entered a new administrative domain.

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to include in the advertisement message of Frid challenge/response and network access identifier extensions as notoriously well-known in the art for the advantages of communicating the latest challenge value that can be used by the mobile node to compute a challenge response which would serve for authentication and to prevent other network entities from using the network identity to intercept packets, and for the advantages of determining if the mobile node has entered a new administrative domain.

8. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barnes in combination with Frid and Leu as applied to claim 1, above and further in view of Einola et al. (hereinafter "Einola"; Patent No.: 6,438,370).

Regarding claim 7, Barnes in combination with Frid and Leu discloses the method according to claim 1 (see above) in which the advertisement (see explanation of claim 1 above) is sent after successful sending and receipt of request, acceptance and completion messages (Barnes: Fig. 5a, references 302, 326a, and 328, respectively), but fails to specifically disclose in which the former and new routing areas are within different radio network controllers, and sending and receipt of radio network controller relocation request, acceptance and completion messages.

However, in the same field of endeavor, Einola discloses in which the former and new routing areas are within different radio network controllers (Figs. 4 and 12), and sending and receipt of radio network controller relocation request, acceptance and completion messages (Fig. 12).

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by applicant to modify the former and new routing areas of Frid to be within different radio network controllers, and sending the advertisement of Barnes in combination with Frid and Leu after successful sending and receipt of radio network controller relocation request, acceptance and completion messages as suggested by Einola for the advantages of allowing successful performance of inter-SGSN handover procedures whereby the radio related entities are maintained (Einola: col. 6, lines 15-20), in addition, to being components already widely available in the art.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIVELISSE SANTIAGO-CORDERO whose telephone number is (571)272-7839. The examiner can normally be reached on Monday through Friday from 8:00am to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (571) 272-7872. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/William Trost/
Supervisory Patent Examiner, Art Unit 2617

/MARIVELISSE SANTIAGO-CORDERO/

Application/Control Number: 10/009,019
Art Unit: 2617

Page 10

Examiner, Art Unit 2617